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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/476,039	12/31/1999	JAMES W. JIMISON	JIM9901C	7226

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EXAMINER

CHIN, RANDALL E

ART UNIT

PAPER NUMBER

1744

DATE MAILED: 06/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/476,039

Applicant(s)

JIMISON, JAMES W.

Examiner

Randall Chin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 3, 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-20 and 23-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claim 3 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 4.
2. Applicant's election of Fig.23, claims 1, 2 and 4-27 in Paper No. 4 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
3. Claims 21 and 22, indicated by applicant as readable on elected Fig.23 in Paper No.4, are being withdrawn from consideration since claims 21 and 22 each depend on non-elected claim 3.

### ***Claim Rejections - 35 USC § 112***

4. Claims 6-8, 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6, line 1, "said material" lacks proper antecedent basis. Claim 7, line 2, it is suggested to change "said thickness" to —said combined thickness—for clarity and to avoid confusion with the language of claim 1. The same concern holds for claims 8, 15 and 16.

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### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claim 17 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14 and 17 of U.S. Patent No. 6,049,938. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to have provided for the inner liner to be removable for the purpose of replacement when worn.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Mosely '756

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9. Mosely '756 clearly discloses all of the recited subject matter as shown in Figs. 2 and 3. With respect to "cleaning and polishing" products, such a recitation merely involves intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

10. Claims 1, 4-8, 23, 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Cooper '936.

The patent to Cooper '936 discloses with respect to claims 1 and 4-6 an apparatus comprising an elongated outer bag 10 having an opening, an inner liner 24 within the outer bag, the inner liner having a thickness of 0.7 mm which converts to 0.027 inches (col.2, lines 30-32), and a means for closing and securing the opening defined by tie 38 (Fig.3). As well as claim 6 is understood, Cooper teaches that printed material or graphics (black biohazard markings) could be on a surface thereof (col.2, lines 49-50). As for claims 7 and 8, Cooper teaches that the outer bag 10 is 100 microns in thickness (col.2, lines 13-16) which converts to 0.004 inches. Therefore, the thickness of a single layer of the outer bag (0.004 inches) and the thickness of a single layer of the inner liner (0.027 inches) have a combined thickness of 0.031 inches which falls

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within the recited ranges of claims 7 and 8. As for claims 23, 26 and 27, Cooper's inner lining 24 serves as the "at least one sheet of material".

With respect to "cleaning and polishing products, including fruits and vegetables", such a recitation merely involves intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Clearly, with the right motion of the bag with contents inside, one can carry out a "cleaning and polishing" function.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 2, 4, 5, 7, 8, 10-16, 18-20, 23, 24, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over EPA 0 158 361 (hereinafter EPA '361).

The EPA '361 reference discloses with respect to claims 1, 4-6 and 10 an apparatus comprising an elongated outer sack or bag 2 having an opening, an inner sack 3 within the outer bag, the inner liner having a thickness of 100 microns which is

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0.004 inches and a means for closing and securing the opening defined by a clamping band 12. One of ordinary skill would find it obvious to use such a clamp or tie to close the outer bag opening also for securement of contents. With respect to the recited range of claim 1 calling for a lower limit of 0.005 inches, a prima facie case of obviousness exists here since the 0.004 inch thickness taught by EPA '361 is close enough such that one skilled in the art would expect them to have the same properties. Furthermore, applicant's claimed range is rather broad stretching from 0.005 inches all the way up to one-tenth of an inch thus minimizing any criticality of the thickness of the claimed inner liner.

As for claim 2, the inner liner 3 could be removed (p.11, lines 3-5, for example), if so desired.

With respect to claims 4, 5, 7, 8, 13-16, 23, 26 and 27, it is the examiner's position that one of ordinary skill in the art would find it obvious to increase the thickness of the inner liner as claimed in order to strengthen the inner liner as well as to ensure the imperviousness of the inner liner which EPA '361 is concerned with (p.9, lines 7-13). The fact that applicant has claimed various values and ranges for the thickness of the inner liner (e.g., claims 1, 4, 5, 7, 8) minimizes any criticality of the thickness of the inner liner being any particular value.

As for claims 11, 12 and 24, EPA '361 teaches in Fig.7 the inner sack or liner 3 having a releasable adhesive patch 5 on a surface thereof comprising a protective cover 9 removably covering the patch 5.

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As for claim 18, the inner liner 3 shown in Fig.7 is considered to be a "folded sheet of material".

As for claim 19, the outer sack or bag 2 is plastic film (p.9, lines 4-7).

As for claim 20, it is the examiner's position that the provision of indicia on the inner liner or on any other portion of the apparatus would be obvious to one of ordinary skill in the art for advertising purposes. Mere printed material or graphics on bags is old and well known.

With respect to "cleaning and polishing products, including fruits and vegetables", such a recitation merely involves intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Clearly, with the right motion of the bag with contents inside, one can carry out a "cleaning and polishing"

### ***Allowable Subject Matter***

13. Claims 9, 17 and 25 define allowable subject matter.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Wicks, McDonald, Dooley, Lofberg, Bonerb,



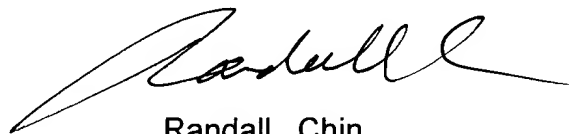
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LaFleur, Bose, Merritt, Pryor, and EPA '706 are pertinent to various layered bag arrangements.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randall Chin whose telephone number is (703) 308-1613. The examiner can normally be reached on Monday through Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Warden can be reached on (703) 308-2920. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Randall Chin  
Primary Examiner  
Art Unit 1744



R. Chin  
June 5, 2002